

Claim Rejections – 35 USC § 102

The Office Action indicates rejection of Claims 18-33 pursuant to 35 USC 102 as being anticipated by Sunstein et al. (U.S. Patent No. 6,985,887). The Applicant respectfully disagrees with this rejection and elects to traverse the rejection. To anticipate a claim pursuant to 102 the reference must teach every element of the claim. *MPEP § 2131*. The Applicant respectfully elects to traverse this rejection because the cited prior-art (the ‘887 Patent) does not teach every element of the subject Claims. The Applicant respectfully requests reconsideration of the rejection and allowance of the subject Claims.

In order for a reference to qualify as prior art pursuant to 35 U.S.C. § 102, the reference must disclose each and every element of the claimed invention. *MPEP § 2131*, citing: *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). The absence of any claimed element in the prior art reference negates a finding of anticipation. *Id.* Also, “the identical invention must be shown in as complete detail as is contained in the... claim.” *Id.* Citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

The Applicant concedes that Sunstein, like the Applicant, deals with databases for managing credit cards. However, the similarities between the two stops there. Sunstein deals with the use of “psychological identifiers” in order to protect credit card information. The Application deals with improvement in the systems and methods employed to allow users to manage their credit cards. Sunstein fails to disclose many of the crucial elements of the Application.

Neither the specific paragraph of the ‘887 Patent that is referenced in the Office

Action (Col. 1, lines 59-67), nor the '887 Patent as a whole, discloses all of the elements of the subject Claims. First, the paragraph cited at Col. 1, lines 59-67 refers very generally to "central credit card registries" that "exist to provide credit card owners with a single point of reference for registering credit card numbers and, optionally, providing selected other services for dealing with lost or stolen credit cards (*e.g.*, notifying credit card issuers of the theft)." The cited paragraph goes on to cite minimization of fraud in such registries as one of the goals of the invention disclosed by the '887 Patent. The cited paragraph states: "a credit card registry may itself be used by an unscrupulous individual to perpetuate identity theft, whereby, for example, a fraudulent change of address may be given to multiple credit card issuers via a credit card registry." The '887 Patent seeks to reduce fraud in "credit card registries" that have been known in the art for some time to allow customers to submit information to multiple card agencies via a single telephone call.

Neither the cited paragraph, nor the related-art, however, disclose the use of an "on-line card management" method for use with a "computer network." The Applicant's system represents a highly desirable improvement on related-art systems because it eliminates the need for human interactions in card management systems. Also, in the related-art systems, a customer would purchase a personal service managed by a customer service representative that could be reached by telephone. With the Applicant's invention, on the other hand, the customer purchases the ability to personally manage his or her own accounts. This improves the customer's ability to tailor the card management system to his or her personal desires while also increasing the efficiency of card management systems.

Furthermore, the cited paragraph from the '887 Patent fails to disclose many of the additional services that are performed by the computer network and disclosed in several of the Applicant's claims including: "request for a new card, notification of a billing dispute, request for a copy of a bill, a change of marital status, a change in name, and a request for an increase in credit line." In summary, because "the absence of any claimed element in the prior art reference negates anticipation," and, "the identical invention must be shown in as complete detail as is contained in the... claim" (*MPEP* § 2131) the failure to teach these crucial elements of the Applicant's Claims indicates that the cited paragraph fails to anticipate the Claims to the standards of 102.

Furthermore, the '887 Patent, when read as a whole, fails to disclose "each and every limitation of the claims" of the Application, as required by *MPEP* § 2131. The '887 Patent is directed towards a "method of assuring integrity of personal information in a data base containing personal information provided by multiple users us[ing] in various embodiments physiological identifiers associated with each of the users." The '887 Patent seeks to reduce fraud over in telephonic customer service calls, such as those used in "central credit card registries." The '887 Patent does not, however, disclose an improved card management system that eliminates the use of telephonic customer service calls. The '887 Patent as a whole fails to disclose several crucial elements of the Applicant's invention, including, but not limited to, an "on-line card management" system over a "computer network." Several other elements of the Claims are, likewise, not disclosed anywhere in the '887 Patent.

In summary, the Applicant respectfully traverses the Office Action's rejection of Claims 18-33 because the requirements of 35 U.S.C. 102 are not actually satisfied by the

‘877 Patent. Pursuant to *MPEP* § 2131, to anticipate a claim, the reference must teach each and every element of that claim. The ‘887 Patent, neither in whole nor in the cited paragraph, teaches many of the important elements of the Applicant’s Claims. Therefore, the Applicant respectfully requests removal of the rejection and solicits prompt allowance of all of the subject Claims.

Claim Rejections – 35 U.S.C. § 103

The Office Action further indicates rejection of Claims 20, 25, and 30 as being unpatentable over Sunstein in view of Scharmer (USPN 5640577), further in view of Mewhinney (USPN 6804346) and further in view of Geerlings (USPN 5956693). 35 *USC* § 103 establishes the non-obviousness standard, which provides that an invention is not patentable if it would have been obvious to a person having ordinary skill in the pertinent art at the time of the claimed invention. A reference is considered analogous and, therefore, available for use in an obviousness rejection if it is either: (1) within the filed of the inventor’s endeavor, or (2) reasonably pertinent to the particular problem with which the inventor involved. *MPEP* 2141.01(a). In reviewing multiple prior art references, the combined references must teach all of the claim limitations. *MPEP* 2141.

These additional references Scharmer, Mewhinney, and Geerlings should not be used for a § 103 analysis because they are neither within the field of the inventor’s endeavor or reasonably pertinent to the particular problem within which the inventor is involved. *Id.* Thus, their use comprises impermissible “hindsight analysis.” *Id.* Scharmer deals with a data processing system that processes data and prepares letters. Mewhinney deals with a dialing system for telephone call centers. Geerlings deals with a system for directing marketing to targeted consumers. The invention, meanwhile, deals

with a system and method for managing credit cards over a computer network. Neither of the referenced patents is within the field of the inventor's endeavor or reasonably pertinent to the particular problem within which the inventor is involved. Therefore, none of the patents should be used to evaluate the Applicant's claims because such use comprises impermissible "hindsight analysis."

Furthermore, none of the prior art references themselves provide a suggestion or motivation to combine their elements. As explained by the Federal Circuit in *Kahn*, most inventions arise from a combination of old elements and each element may often be found in the prior art. *In re Kahn*, 441 F.3d 977, 987 (Fed. Cir. 2006). However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. *Id.* In practice, this requires an explanation of the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. *Id.* In this case no suggestion or motivation is supplied by the prior art because none of the references deal in the inventor's field of endeavor.

The "motivation-suggestion-teaching" requirement protects against the entry of hindsight into the obviousness analysis, a problem which § 103 was meant to confront. *Kahn* at 986. It is this phrase that guards against entry into the tempting but forbidden zone of hindsight." (internal quotations omitted)); *Id.* Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability-- ***the essence of hindsight.***" (emphasis added), *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

The Office Action performs this type of analysis by combining references from unrelated arts using the inventor's claims as a blueprint to defeat patentability.

In summary, none of the combined references, alone or in combination, discloses the inventor's substantial improvements and innovations on current credit card management technology. The Applicant's invention represents marked improvements on current technologies and, as such, should be entitled to allowance of the subject claims.

Opportunity for Examiner Interview

In the event that the Examiner remains unconvinced of the Applicant's arguments or requires further clarification of the claimed intent, the Applicant invites the opportunity to hold a telephonic Interview at a convenient time for the Examiner in order to clarify these matters, prior to issuance of further Office Actions.

CONCLUSION

Applicant respectfully requests reconsideration of the patent application in light of the foregoing and earnestly solicits that all of the Applicant's currently pending Claims be allowed as amended. The Examiner is invited to contact Applicant's undersigned counsel by e-mail (Marc@HankinPatentLaw.com) or by telephone at (310) 892-1613 to expedite the prosecution of this case should there be any unresolved matters remaining.

Respectfully Submitted,

/Marc E. Hankin/

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